

Application No. 09/324,249
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Reply to Office Action of December 3, 2003

Remarks/ Arguments

Applicant respectfully submits the following remarks and arguments with respect to claims rejected in the second office action in this case. Per MPEP section 1.116(c), Applicant submits that amendments herein are presented after final rejection, but touch the merits of the application under reexamination, and Applicant requests that these amendments be considered as they could not have been earlier presented because they respond to new prior art presented in such second office action. Claims 1- 6, and 8-18 are currently rejected and remain in this application. All previously presented Claims, except Claims 4 and 7, are hereby amended. Claims 7 is hereby canceled for the reasons given herein. This amendment is intended as a Request for Continuing Examination submission under 37 CFR 1.114.

Claim 18 remains rejected under 35 U.S.C. 102(e) as being anticipated by Criss et al (US 2001/0029178 A1) which was filed on 6/7/01, as continuation of 09/234,813, which is cip of 09/023,857 filed 2/13/98 now U.S.Pat. 6,031,830, which is continuation of 08/694,637 filed 8/7/96 now USPat 5,848,064.

Examiner cites the Criss '178 disclosure at page 7, paragraph 0071, of *"Communication regarding the software stored in the mobile terminal 36 may now occur by referring to the assigned package name. It will be appreciated that while in the present embodiment the boot up procedure is shown to generally follow a bootp protocol, a dynamic host configuration protocol (DHCP) could alternatively be used. Still further, the boot up procedure could optionally be avoided altogether by directly/manually inputting the needed boot up information into the mobile terminal 36 including information such as, for example, the IP address of the mobile terminal 36 and the name of the server with which the mobile terminal 36 is to communicate."* (emphasis added), to demonstrate Criss' disclosure of the mobile terminal 36 already containing a destination address associated with a remote server.

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Applicant respectfully submits that this particular portion of the Criss '178 disclosure is an improper reference under 35 U.S.C. 102(e), because (based on a comparison of Criss' US Patent No. 6,308,061 and Cowan US Patent 6,031,830) the language quoted above was only added to the Criss specification filed on January 21, 1999 (the date when Criss was added as an inventor), and was accordingly filed after the provisional application date of the present Application (June 2, 1998).

The prior specification (Cowan) discloses in this regard only that "As is conventional, each wireless base station 28 associates itself, typically by registration, with another base station, whether hardwired or wireless, such that a link is formed between itself and other devices situated on the system backbone 24. For example, in the system 20 shown in FIG. 1 a wireless base station 28 associates itself with one of the base stations 26 connected to the system backbone 24 so that a communication link is formed between the wireless base station 28 and a host computer 30 also coupled to the system backbone 24. All communications between the wireless base station 28 and a device on the system backbone 24 are made possible by the other base stations on the link which are configured to relay communications therebetween.... Each mobile terminal 36 communicates with devices on the system backbone 24 via a selected base station 26, 28 and/or with other mobile terminals 36. Upon roaming from one cell 34 to another, the mobile terminal 36 is configured to associate itself with a new base station 26, 28 according to conventional techniques. ...When a mobile terminal 36 within the system initially powers up (via an on/off switch for example) or is reset, the mobile terminal 36 goes through an initialization, or boot-up routine. Such routine includes communicating with the host computer 30 via a selected base station 26 in order that the host computer 30 provides the mobile terminal 36 with its internet protocol (IP) address as is conventional." As stated previously, this disclosure only teaches a method whereby the mobile terminal contacts a base station, which in turn knows where to contact the host computer, and does not disclose that the mobile terminal

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knows a host computer IP address until it goes through this process and the host computer provides its IP address to the mobile terminal.

Accordingly, Applicant submits that Cowan, not Criss, is the proper prior art reference for purposes of the present invention, and Cowan does not disclose a mobile terminal that initially includes an address associated with a remote server. However, the present specification discloses a wireless device that contains an IP or destination address associated with the server, as claimed in Claim 18. Applicant respectfully submits that for this reason, Claim 18 is not anticipated by Criss '178.

Applicant submits that another novel feature of present invention as compared to Criss '178 is that the configuration table data is user data created on the server through a user interface (Figs 7-11) where the user can update this data by using a full-size keyboard and any PC browser accessing the user's account on the server (as opposed to the tiny keyboard interfaces of many wireless devices). This data is then transmitted from the server to the wireless device where it is accessible through a wireless device user interface (Figs. 4-6). Thus, in the present invention, configuration table data is specific to the user and the wireless device used by that user. Applicant submits herewith revisions to claim 18 to specify that the wireless device data is user data from the server, and respectfully submits that the present invention of this amended Claim 18 is not anticipated by Criss.

Regarding claim 18, Examiner states that Safi '469 discloses a method in a data processing system for transmitting an image to a remote system associated with a predetermined destination address (figs. 4A-4F), including the step of "registering with a wireless packet data network". Applicant respectfully submits again that in the previously submitted Claim 16 invention this registering process is automatic and provides a network connection that is always available, and is preferred in the present invention because it simplifies the transmission process and eliminates time required to establish a network connection before commencing the transmission process. Safi on the other hand at column 13, lines 39+ discloses that the network connection is only established when the

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send button is pressed (notably after addresses have been entered, and photo's selected by the Safi user) and then is maintained only for the duration of the transmission (col. 14, lines 1-8). However, without wishing to concede this point, Applicant traverses this rejection by submitting herewith revised claim 16, which is revised to specifically claim the presently disclosed invention where the wireless device configuration table includes one or more recipient codes, which are displayed and selected for inclusion in messages sent to the server. A displayed recipient code is selected, not entered, by the device user, and the address of this invention is a predefined server address which is then able to process the message based on the selected recipient code. In regard to Examiner's comments on page 5 of the current office action regarding a destination address, Applicant supplements earlier arguments regarding a destination address by saying that even if one were to argue that this destination address as previously claimed in Claim 16 "reads on" the address of the Safi server 601 Applicant notes that Safi only uses the destination address phrase, as at column 13, line10+, in reference to the email address, postal address, etc "indicated in the confirmation box 456". Applicant further submits that Safi only discloses use of recipient addresses that are in all cases at least partially entered by the device user at the time the 'message' is composed, whereas in the present invention of claim 16, the address is previously stored on the wireless device. Accordingly, Applicant respectfully submits that the present invention of Claim 16, as amended herewith, is not anticipated by Safi.

Regarding Claim 17, Claim 17 is herewith amended to claim a method that includes transmission of an image in the invention of Claim 16.

Regarding the rejection of Claim 2 under 35 U.S.C. 112, second paragraph as being indefinite, due to insufficient antecedent basis for "said message" as used in line 4 of this Claim, Applicant respectfully requests that Examiner explain the reasoning behind this rejection in more detail. Applicant submits that the message being referred back to, was found in Claim 1 of

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Applicant's First Amendment dated October 9, 2003, and is also in the current Claim 1. Applicant believes this issue is presently moot given the current amendments but if not, would appreciate any suggestion by Examiner, as provided in MPEP section 2173.05(e) of changes that would correct this problem.

Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilska et al. (US 6,427,078 B1). In particular, Examiner argues that Wilska '078 discloses processor control means "for transmitting one or more messages including at least a recipient code (i.e. see col. 8, lines 1-5)... to said remote system (i.e. see col. 8, lines 30+)." Applicant respectfully submits that Wilska only discloses a 'phone list' that "is generally an application which offers an easy way to select the address information of the recipient for a chosen electronic contact as well as for a possible written letter" (Wilska, col 7, lines 57+) and that this address file may include phone numbers and email addresses. Without wishing to belabor the point, Applicant disagrees that this phone list is analogous to the displayed list of recipient codes of Claim 9. Rather, Wilska discloses at col 8, lines 1-4 that "It depends on the application selected for the notebook computer, **which information the user chooses from the phone list and connects to the message to be transmitted**" (emphasis added), and so the Wilska user can *select* the appropriate form of address from the phone list (facsimile number, email or mailing address). The present invention is different, in that the user selects a single recipient code, and while this recipient code may correspond to various information in the configuration table stored on the remote server and comparable to the Wilska phone list, or even to an IP address in a configuration table on the wireless device, the recipient code is not necessarily the recipient's address but is rather a user-selected field that allows the user to indicate who the message is going to, without having to enter or copy an address from an address book or phone list as in Wilska. Again, Applicant submits that there is nothing in the Wilska disclosure comparable to the recipient code of the present invention. Applicant submits that when Wilska discusses an address or recipient, this means the recipient's actual *address, fax or email address* which is

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entered via user interface, "scanned" by the camera, or at best copied from the phone list, and it is hindsight reconstruction to say that the word "recipient" in Wilaka means a recipient code or nickname as disclosed by the present invention. Accordingly, Applicant respectfully submits that the invention of Claim 9 or dependent Claim 10 as previously presented, and as amended, are not anticipated by Wilaka.

Claims 1-6 and 8 are rejected under 35 USC 103(a) as being unpatentable over Safi '469 in view of Davis (U.S. 5,966,446).

Regarding Claim 1, Examiner states that "although it is clearly obvious and well known in the art to automatically establish the communication link"... "Safi '469 does not explicitly state "automatically establishing a link... whenever possible". And, as evidence that this limitation is well known in the art, Examiner cites Davis '446 as teaching "automatically establishing a link between the RF communication device and the remote system whenever possible" as recited in the prior Claim 1.

Per MPEP section 2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." And per MPEP 2143.01: "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998); "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzeb*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

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As argued by Applicant in the prior Amendment, Safal does not disclose an 'always on' e-camera, with an enduring network connection, but rather, Safi teaches away from this by saying at col. 12, line 17+, "the user is expected to connect a cable from the camera to a telecommunication device or network. For example, when communication port 214 is a modem, the user connects it to a telephone jack that is coupled to the public switched telephone network". While Safi does say at col. 18, line 13 "Wireless links may also be implemented" this does not begin to describe the function of the present invention that automatically establishes a wireless packet data network connection via wireless link whenever the apparatus is activated and environmental conditions permit establishing such a connection, without requiring any subsequent user action to re-initiated the link if it is subsequently lost and recovered, per the invention of Claim 1 as presently amended. On the contrary, Safi at col. 13, lines 10+ and 41+ teaches dialing a predefined telephone number, and terminating the connection following transport at col. 14, lines 3+.

In order to show that automatically establishing a RF network connection is well known in the art, Examiner cites Davis '446 as teaching (col 4, lines 50+) that "Establishing the link may be based on an automatic, periodic basis or in response to an action (e.g., turning on the capturing device 200)." and Examiner goes on to say that this is "so that highly reliable communication links... may be realized". Applicant respectfully submits that this is mere hindsight reconstruction, as Applicant can find no teaching or suggestion in Davis that establishing 'reliable links' was the purpose behind automatically establishing such a link in Davis, and submits that neither Davis nor Safi teach establishing an enduring "always-available" communication link as in the present invention of Claim 1. In fact, while Davis does say the link may be established automatically, there is nothing in Davis that teaches a preference for establishing and maintaining the link (on the contrary, to Applicant, it appears that Davis teaches establishing an intermittent link, because establishing the link on a 'periodic' basis implies that the link is only established long enough to receive a new state value, and then is disconnected, to be re-established thereafter on a periodic

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basis). In the present invention, this purpose of this enduring network connection is to minimize delay before a message formed on the device is transmitted, to allow near-real time receipt of information from the server when the server configuration table is updated or when messages addressed to the wireless apparatus are transmitted by the server, and in the preferred embodiment, with a wireless packet data RF modem, to allow means for transmitting messages directly through the packet network to a devices at known IP addresses. In an emergency situation, the seconds required to establish a communication link via circuit switched cellular technology as taught by Safi and Davis could be critical, and this delay is not incurred in the present invention. So, in summary, Applicant can find no motivation for combining Safi and Davis, nor can Applicant find a teaching of the "always on" network connection limitation of present Claim 1 as amended [processor control means for: establishing a persistent link between said RF communications device and an external network when the apparatus is first activated and thereafter whenever the processor detects that the external network is not available]. Accordingly, Applicant submits that the present invention of Claim 1 (or of dependent Claims 2-6 and 8) is not disclosed by Safai '469 or Davis '446 individually, and lacking any suggestion or motivation in Safi or Davis to modify or combine their teaching to create the present invention of Claim 1, the present invention of Claim 1 (or of dependent Claims 2-6 and 8) is not obvious over Safai '469 in view of Davis '446.

Although Claim 7 as dependent from Claim 1 should now be in condition for allowance, Applicant does not believe the addition of a serial port is material to the present invention and accordingly Claim 7 is hereby canceled.

Regarding Claim 11, currently rejected under 35 U.S.C. 103(a) as being unpatentable over Safi '469 in view of Harris et al (U.S. 6,009,336), Applicant submits that (a) the recipient code of the present invention is not disclosed by Safi, (b) there is no motivation to combine Safi and Harris, and (c) even if there were a motivation to combine Safi and Harris, this would not result in the current

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invention of Claim 11 because neither Safi nor Harris disclose use and transfer of messages with recipient codes from a wireless device to a server where messages are processed according to data associated on the server with the recipient code (Claim 11 is hereby amended to clarify that this data is on the server and associated with the recipient code, and is not received with the message).

Harris discloses in relation to Fig. 10 that "Upon detection of touching the touchscreen 186 at the phonebook softkey 203 while a name (such as "Michael Smith" in FIG. 10) is highlighted by a cursor 1006, the controller 118 retrieves a telephone number associated with the name." Applicant respectfully submits that while Harris does not say what can be done with the retrieved telephone number, the only obvious conclusion to Applicant is that the Harris device could transfer this number to the telephone mode operation in order to initiate a call. By analogy one could also imagine that if Harris does this for a phone number, a similar function might be available for email addresses (although Applicant cannot find this in the Harris disclosure and by saying this may himself be guilty of a bit of hindsight reconstruction). However, in Applicant's opinion it takes quite a leap to move from this idea to the present claim 11 element of **"server control means for... processing each said message according to account configuration data associated with said recipient code"**. Harris '336 does not disclose anything like the recipient code or "nickname" of the present invention as shown in present figures 8 and 9, where figure 8 is a summary screen showing several recipients, their associated recipient code/nickname, and primary email address, and figure 9 is a detailed view of one of these recipient records with a recipient code/nickname of 'Jeff' and multiple addresses to which, if present, the server could use to deliver messages. Assuming solely for the sake of argument that Harris did have a "phonebook" for email addresses as discussed above, to Applicant the only obvious result would be to format an email message on the radiotelephone, with an address retrieved from the phonebook, and send it to the communication device 102, where it presumably would be forwarded in a standard email format. Applicant submits that this is

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significantly different from the present invention of Claim 11, and does not include the element quoted above. For these reasons, Applicant respectfully submits that the invention of Claim 11 is not obvious over Safi '469 in view of Harris '336.

Regarding Claim 14, currently rejected under 35 U.S.C. 103(a) as being unpatentable over Safi '469 in view of Harris et al (U.S. 6,009,336), Applicant submits that this dependent claim should be allowable if base Claim 9 is allowed. Regardless, Claim 14 is herewith amended to claim an embodiment of the invention of Claim 9 where the modem is capable of operating according to at least two protocols.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safi '469 in view of Criss et al. (US 2001/0029178 A1), but then proceeds to argue a combination of Safi '469, Harris '336, and Criss '178. Accordingly, the following arguments are presented in response to a rejection of Claim 12 under 35 U.S.C. 103(a) as being unpatentable over Safi '469 in view of Harris '336 and Criss '178. Applicant submits that neither Safi, Harris, nor Criss, expressly or impliedly suggest the claimed invention and the Examiner has not presented any motivation for combining these references to achieve the invention of Claim 12. While Applicant agrees that Criss teaches a solution that helps reduce downtime or service costs associated with upgrading a mobile device, that was not the primary motivation behind transmitting configuration table data from the server to the mobile device in the invention of Claim 12 (which was motivated at least in part by a recognition that the wireless device has a limited and awkward user interface with which to enter or update configuration table data). But, even if the motivation of Criss had led someone to transmit software, or even data, from a remote server to the wireless device, Applicant respectfully submits that this would still provide insufficient motivation, nor would it be obvious, to produce the invention of Claim 12, including all elements of base Claim 11. Therefore, for this and the reasons discussed above regarding the section 103(a) rejection of Claim

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11, Applicant submits that Safi in view of Harris does not include all the limitations of present Claim 11, and is therefore an improper reference for a section 103 rejection of Claim 12 in further combination with Criss. Accordingly Applicant respectfully submits that Claim 12 is in allowable form, as previously submitted and as currently amended.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safi '469 in view of Harris '336 as discussed above and further in view of Fernandez (US 2002/0057340).

Applicant submits that neither Safi, Harris, nor Fernandez, expressly or impliedly suggest the invention of Claim 13 and the Examiner has not presented a convincing line of reasoning as to why anyone would find it obvious to conceive of the claimed invention in light of these references' teachings.

For this reason, and the reasons discussed above in reference to the section 103(a) rejection of Claim 9, Applicant submits that Safi in view of Harris does not include all the limitations of prior Claim 11, and are therefore an improper reference for a section 103 rejection of Claim 13 in combination with Fernandez. Accordingly Applicant respectfully submits that prior Claim 13 was in allowable form, and as amended, is allowable as depending from Claim 9.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Safi '469 in view of Harris '336 as discussed above and further in view of Harkins et al. (US 5,689,642).

Applicant submits that neither Safi, Harris, nor Harkins, expressly or impliedly suggest the invention of Claim 15 and the Examiner has not presented a convincing line of reasoning as to why anyone would find it obvious to conceive of the claimed invention in light of these references' teachings.

For this reason, and the reasons discussed above in reference to the section 103(a) rejection of Claim 11, Applicant submits that Safi in view of Harris does not include all the limitations of present Claim 11, and is therefore an improper reference for a section 103 rejection of Claim 15 in combination with

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Harkins. Accordingly Applicant respectfully submits that present Claim 15 is in allowable form.

New Claims 19-35 are submitted herewith to claim disclosed embodiments not previously claimed.

Applicant submits herewith new Claim 28, which is based on previous Claim 16, but claims steps of capturing, formatting and transmitting each image in response to a single user input, in order to represent process steps of the present invention that are not disclosed by Safi. In an embodiment of the present invention, as claimed here, images are automatically captured and transmitted to the remote system - with default attributes (recipient code/ classification) or attributes selected by the user before a picture is taken - without requiring additional user intervention after a picture is taken to select an image and address it, this process is much simpler than the process disclosed by Safi where the user must go through separate steps to address, and then select photos to send.

Applicant notes that when in reference to prior Claim 17, on which current new claim 29 is based, Examiner argues that retrieval of one or more preselected recipient addresses corresponding to a recipient code in the message is disclosed by Safi '469 by saying "claim 9 alternatively recited that the remote system retrieves one or more preselected recipient address, thus, it is sufficient to show the process of selecting at least one preselected recipient address, such as a specific address included in the transport application...". Applicant interprets this as a reference to claim 9 of Safi and respectfully submits that in Safi claim 9 refers to images, not addresses. And, while Examiner implies that Safi discloses recipient codes, as disclosed in the present invention, Applicant can find nothing in Safi that teaches entering a code (that corresponds to an email address), but rather Safi only discloses entering actual addresses, whether postal or email (see Figures 4B, 4E and 4F and descriptions thereof), and while these can be supplemented by an auto-complete function as shown at Safi col 9,

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lines 14+, that does not equate to anything like the recipient code of the present invention. Accordingly, Applicant respectfully submits that new claim 29 is not anticipated by Safi.

As explained herein, Applicant respectfully submits that the present Claims 1- 6 and 8 – 18, and new claims 19 - 35 are not anticipated by the cited references, nor are these obvious over the cited references, and accordingly are now in a condition for allowance.

Respectfully submitted,



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